REMARKS

Claims 1-10 are pending in the application. Claims 1-10 were rejected by the Examiner. The Applicant has cancelled Claims 1-9. The Applicant has amended Claim 10. The Applicant adds new claims 11-13. All amended and new claims are fully supported in the specification and no new material is added.

The Examiner is respectfully requested to reconsider the rejection of this Application in light of the claim amendments, new claims and remarks herein.

Claim Rejections

35 U.S.C. § 112

Claims 8-10

The Examiner rejected Claims 8 and 10 under 35 U.S.C. § 112, second paragraph, for use of "in the shape of a human foot." Claim 8 has been cancelled. The Applicant has amended Claim 10 to remove the recitation "in the shape of a human foot." It is believed that amended independent Claim 10 now overcomes the examiner's grounds for rejection.

The Examiner rejected Claim 9 under 35 U.S.C. § 112, second paragraph, as being solely functional and not making clear what structural limitations applicant intends to encompass with such language. Claim 9 has been cancelled.

35 U.S.C. § 102

Claims 1, 2, 8, and 9

The Examiner has rejected Claim 1, 2, 8, and 9 under 35 U.S.C. § 102(b) as being anticipated by Gardner (4,862,605).

Applicant has cancelled Claims 1, 2, 8, and 9.

35 U.S.C. § 103

Claims 7 under Gardner

The Examiner rejected Claim 7 under 35 U.S.C. §103(a) as being unpatentable under Gardner.

Applicant has cancelled Claim 7.

Claims 3-6 and 10 under Gardner in view of Fisher

The Examiner rejected Claim 3-6 and 10 under 35 U.S.C. §103(a) as being unpatentable under Gardner in view of Fisher (5,611,153).

In making the rejection, the Examiner stated:

> Regarding Claims 3-6 and 10, Gardner shows an insert pad made of foam with planar surfaces substantially as claimed except for the exact foam material. Fisher teaches the use of polyethylene vinyl acetate foam with a density of between 2 and 35 pounds per cubic foot for an insert pad. It would have been obvious to use the material taught by Fisher in the pad of Gardner to provide adequate shock absorbing properties.

Applicant has cancelled Claims 3-6 and Claim 10 has been amended to recite: " A shoe insert pad, comprising: a planar surface; a second planar surface; and a uniform edge defining the first planar surface and second planar surface; wherein the shoe insert pad is formed of polyethylene vinyl acetate material having a density between 8 and 9 pounds per cubic foot."

In Gardner, the insole consists of a single layer that is tapered both from front to back, with the back edge being thicker than the front edge, and from the outer lateral edge to the inner medial edge, where the outer lateral edge is thicker than the inner medial edge.

In Fisher, the insole consists of a shock-absorbing layer that may be made of polyethylene vinyl acetate, among other materials. Fisher further describes an insole with a polyethylene vinyl chloride shock-absorbing layer that consists of a cupped heel and various non-planar tapers and contours.

Both Gardner and Fisher teach a non-uniform thickness. In contrast, Claim 10 describes a shoe insert pad having "...a uniform edge with a thickness of 3/16 inches," which is not taught or suggested in the Gardner or Fisher references.

In addition, there is no motivation for one of ordinary skill in the art to combine the Gardner and Fisher devices to obtain the applicant's claimed invention as claimed in Applicant's amended independent Claim 10.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must demonstrate that there is a suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine the reference teachings. Furthermore, the prior art references must teach or suggest all of the claim features. It is well settled law that the prior art itself must provide the motivation for a proposed alteration of a reference. Ex parte Chicago Rawhide Manufacturing Co., 220 U.S.P.Q. 351, (B.O.P.A. 1984). Moreover, the suggestion must be plain and clear or the rejection is untenable. Fromson v. Offset Plate, Inc., 225 U.S.P.Q. 26, 32 (Fed. Cir. 1985); Kimberly-Clark Corp. v. Johnson & Johnson, 223 U.S.P.Q. 603, 610 (Fed. Cir. 1984). The Examiner is not free to pick bits and pieces from the prior art and, with the hindsight benefit of applicants' disclosure,

attempt to reconstruct the invention. Orthopedic Equipment, Inc. v. U.S., 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

Therefore, Applicant's amended independent Claim 10 is patentable over either the Gardner or Fisher references, whether taken alone or in combination with one another.

CONCLUSION

In view of the foregoing amendment and remarks, it is believed that this Application is now in condition for allowance. Early and favorable reconsideration is respectfully solicited.

If the Examiner has any questions regarding the foregoing amendment and remarks, or if prosecution of this Application could be furthered by a telephone interview, the Examiner is requested to telephone the Applicants' undersigned attorney.

Respectfully submitted,

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Dated: 3/28/05

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